PATENT

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2765

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
GARRISON et al.

Serial No. 08/994,047

Filed: December 19, 1997

: Group Art Unit: 2765

: Examiner: Boyce Robinson

For: AN ELECTRONIC BILL PAYMENT SYSTEM WITH MERCHANT IDENTIFICATION

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Honorable Assistant
Commissioner
   for Patents
Washington, DC   20231

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Sir:

An Appeal Brief is submitted herewith in triplicate, in support of the Notice of Appeal filed December 11, 2000. A check for the Appeal Brief fee, in the amount of $310.00, is enclosed.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 12-0429, including any patent application processing fees under 37 CFR 1.17.

Respectfully Submitted,

LALOS & KEEGAN
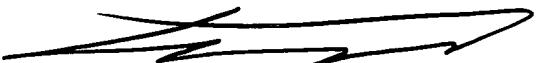
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GARRISON et al.   : Group Art Unit: 2765

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For: AN ELECTRONIC BILL PAYMENT SYSTEM WITH MERCHANT
IDENTIFICATION

APPEAL BRIEF

Honorable Assistant
Commissioner
     for Patents
Washington, DC 20231

Sir:

     This Appeal Brief is submitted in support of the Notice of
Appeal filed December 11, 2000.

I. REAL PARTY IN INTEREST

CheckFree Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

     NONE

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III.   STATUS OF CLAIMS

Claims 1-11 and 13-28 are pending.   Each of claims 1-11 and 13-28 is under appeal.

IV.   STATUS OF AMENDMENTS

An amendment was filed on August 31, 1999 and has been entered. A Request for Reconsideration was filed on September 29, 2000.

V.   SUMMARY OF INVENTION

The present application is directed to an electronic payment remittance processing technique that facilitates the accessing of the proper payee records based on the payment information provided by a payor.   Access to the proper payee record is necessary to ensure that payment is made to the correct person or entity.

As summarized on page 7, line 17, through page 8, line 13, in accordance with the invention, payment information (typically including a payee name and address, and the payor account number with the payee, is transmitted from a payor station.   A payment processing station receives the transmitted payment information and account number and processes the payment information (preferably other than a received zip code) to identify a zip code.   The payment processing station then uses this identified zip code to access stored payee records, typically in a database, to locate the payee record with the corresponding zip code (i.e. the proper payee record).   Additional aspects of the invention are also disclosed and claimed, as will be summarized below.

As recited in claim 1 and described with reference to Figures 2-4, and page 13, line 17 through page 20, line 25, a computer implemented method for payment remittance processing, includes establishing a database (e.g. database 18) including payee records (e.g. records 1-N of Figure 4). Each payee record has a payee zip code (see page 16, lines 2-5).   A payor's (e.g. consumer's 8) payment information (e.g. consumer payment record),

including a payee zip code, is received (e.g. as in step 60 of Figure 3 by processor 17 of RPP 3, and described on page 18, lines 1-13 and 18-21). The payment information, other than the received payee zip code is processed (e.g. as in step 66 of Figure 3, by the processor 17 of RPP 3 and described on page 19, lines 5-17) to identify an eleven digit zip code (e.g. zip 82 of Figure 4) for a payee. The database (e.g. merchant database 18) is accessed (e.g. as in step 66 of Figure 4 by the processor 17 of RPP 3 and described page 19, lines 18-23) to locate the payee record (e.g. record 1-N of Figure 4) having the payee zip code corresponding to the identified eleven-digit zip code (e.g. zip code 82).

As recited in claim 2, the received payment information (e.g. the consumer payment record) preferably includes the received payee zip code and other payee address information (e.g. as described on page 18, lines 1-7). However, the payment information processed (e.g. in step 66 of Figure 3) preferably includes only a portion of the other payee address information (e.g. as described on page 19, lines 6-17).

According to claim 3, the received payment information (e.g. the consumer payment record) preferably includes a payee city and a payee state (e.g. as described on page 18, lines 4-7). The payment information processed (e.g. in step 66 of Figure 3) includes the payee city and the payee state (e.g. as described on page 19, lines 6-17).

As recited in claim 4, each payee record (e.g. record 1-N of Figure 4) has a payee name (e.g. as described on page 16, lines 2-5). The received payment information (e.g. consumer payment record) includes a payee name (e.g. as described on page 18, lines 4-7). The database (e.g. merchant database 18) is accessed (e.g. in step 66 of Figure 3) to locate the payee record (e.g. record 1-N of Figure 4) having the payee name and the zip code corresponding to only a portion of the received payee name and the identified eleven digit zip code (e.g. as in step 67 of Figure 4, and described on page 20, lines 1-19).

According to claim 5, preferably the payee record (e.g.

record 1-N of Figure 4) is located by matching (e.g. in step 67 of Figure 4, and described on page 20, lines 1-19) the identified eleven digit zip code (e.g. zip code 82 of Figure 4) with the payee record zip code in the database (e.g. merchant database 18), and matching the portion of the received payee name (e.g. the merchant name in the consumer payment record) with a portion of the payee record (e.g. record 1-N of Figure 4) payee name in the database (e.g. merchant database 18).

As recited in claim 6, typically a payment (e.g. as described on page 15, lines 2-24 and page 20, lines 20-21) is made (e.g. in step 64 of Figure 4 by merchant payment component 24) to the payee after locating (e.g. in step 67 of Figure 4) the payee record (e.g. record 1-N of Figure 4).

According to claim 7, the payment may be an electronic payment (e.g. as described on page 15, lines 2-24).

As recited in claim 8 and with reference to Figure 6 and page 23, line 1, through page 25, line 19, the received payment information (e.g. the consumer payment record) preferably includes a payor account number with the payee (e.g. as described on page 23, lines 2-4), the database (e.g. merchant database 18) includes alteration rules (e.g. alteration rules 44 of Figure 6) for altering the account number (e.g. as described on page 24, line 19, through page 25, line 19) and validation rules (e.g. validation templates 40 of Figure 6) corresponding to payee values for fields of the account number for validating the account number (e.g. as described on page 23, line 14, through page 24, line 18). In this regard, account number conformance to the validation rules (e.g. validation templates 40) is verified (e.g. in step 42 of Figure 6 by the RPP 3, as described on page 24, lines 9-18). The verified account number is transformed (e.g. in step 46 of Figure 6 by the RPP 3, as described on page 25, lines 6-19) into an altered account number according to the alteration rules (e.g. alteration rules 44 of Figure 6).

According to claim 9 and with reference to Figure 5 and page 21, line 1, through page 22, line 25, the payee has a plurality of remittance centers (e.g. as described on 21, lines 11-14).

The account number is processed (e.g. in steps 53 and 55 of Figure 5 by the RPP 3, as described on page 21, line 14, through page 22, line 17, to identify one of the plurality of remittance centers to which payment is to be remitted. The payment and the altered account number are then directed to the identified remittance center (e.g. in step 58 by the RPP 3, as described on page 21, lines 17-19).

According to other aspects of the invention, and as recited in claim 10 and described with reference to Figures 2-4 and page 13, line 17 through page 20, line 25, a computer implemented process for ensuring the integrity of data includes receiving name, street address, city and state information associated with a merchant (e.g. the consumer payment record as described on page 18, lines 4-7). The name, city and state information is processed (e.g. in step 66 of Figure 3 by the processor 17 of RPP 3, as describe on page 19, lines 5-17) to identify an eleven digit zip code (e.g. zip 82 of Figure 4). A database of merchant records (e.g. merchant database 18) is accessed (e.g. in step 66 of Figure 4, as described on page 19, lines 18-23) to locate a merchant record (e.g. record 1-N in Figure 4) for the merchant corresponding to the eleven digit zip code (e.g. zip code 82).

According to other aspects of the invention, and as recited in claim 11 and with reference to Figures 2-4 and page 13, line 17 through page 20, line 25, an automated remittance processing system (e.g. RPP 3), includes a storage device (e.g. merchant database 18) configured to store payee records (e.g. records 1-N in Figure 4). Each payee record (e.g. record 1-N in Figure 4) has an associated one of a plurality of payee zip codes (e.g. as described on page 16, lines 2-5). A data input unit (e.g. batch file processing unit 7) is configured to receive a payor's payment information (e.g. a consumer payment record), including a zip code of a payee (e.g. as described page 14, lines 16-24, and page 18, lines 1-7). A processor (e.g. RPP processor 17) is configured to process (e.g. in step 66 of Figure 3 by the processor 17 of RPP 3, as described on page 19, line 5, through page 20, line 13) the payment information (e.g. the consumer

payment record), excluding the received payee zip code, to produce an eleven-digit zip code (e.g. zip code 82) for the payee, and to retrieve one or more of the plurality of payee records (e.g. record(s) 1-N in Figure 4) having the associated zip code corresponding to the eleven-digit zip code (e.g. zip code 82) from the storage device (e.g. merchant database 18).

According to claim 12, the processor (e.g. in step 66 of Figure 3 by the processor 17 of RPP 3, as described on page 19, line 23 through page 20, line 13) is further configured to retrieve payee records corresponding to the eleven digit zip code (e.g. zip code 82) from the storage device (e.g. merchant database 18).

As recited in claim 13, the processor (e.g. in step 64 of Figure 3 by the processor 17 of RPP 3, as described on page 15, lines 2-24, and page 20, lines 20-21) is further configured to direct a payment to the payee in accordance with the retrieved payee record (e.g. record 1-N in Figure 4).

According to claim 14 and with reference to Figure 6 and page 23, line 1, through page 25, line 19, the payment information (e.g. the consumer payment record) typically includes a payor account number with the payee (e.g. as described on page 23, lines 2-4). The storage device (e.g. merchant database 18) is further configured to store verification rules (e.g. validation templates 40 of Figure 6) corresponding to payee values for fields of the account number (e.g. as described on page 23, line 14, through page 24, line 18) and alteration rules (e.g. alteration rules 44 of Figure 6), associated with the payee (e.g. as described on page 24, line 19, through page 25, line 19). The processor (e.g. processor 17 of RPP 3) is preferably further configured to process the payment information (e.g. the consumer payment record) to verify (e.g. in step 42 of Figure 6, as described on page 24, lines 9-18) that the payor account number conforms to the validation rules (e.g. validation templates 40 of Figure 6) associated with the payee and to alter (e.g. in step 46 of Figure 6, as described on page 25, lines 6-

19) the payor account number according to the alteration rules (e.g. alteration rules 44 of Figure 6) associated with the payee.

According to claim 15 and with reference to Figure 5 and page 21, line 1, through page 22, line 25, the payee may have a plurality of remittance centers (e.g. as described on page 21, lines 11-14). The processor (e.g. processor 17 of RPP 3) is preferably further configured to process (e.g. in steps 53 and 55 of Figure 5, as described on page 21, line 14, through page 22, line 17) the payor account number to identify a single remittance center of the plurality of remittance centers to which payment is to be directed and to direct payment (e.g. in step 58 of Figure 5, as described on page 21, lines 17-19) to the single remittance center.

Claims 16-21 are directed to a software implementation of the present invention. As, for example, shown in Figure 2 and described on page 13, lines 17-20, the functions of the RPP 3 can be implemented using programmed instructions stored on the memory 16, which are executed by the processor 17. These claims are not further discussed in this section of the brief to avoid unnecessary redundancy.

Claims 22-27 are directed to a system embodiment of the present invention. As, for example, described in Figure 1 and on page 12, line 18, through page 13, line 4, and page 14, lines 3-4 and 16-21, a first station, such as consumer station 8, is coupled to a network, such as network 1, and configured to generate payment information, such as the consumer payment record. A database, such as merchant database 18, stores the payee records, such as records 1-N in Figure 4. A second station, such as the RPP station 3, is coupled to the network (e.g. the network 1), and configured to receive the payment information (e.g. the consumer payment record) from the first station (e.g. the consumer station 8) via the network (e.g. the network 1), and process the payment information (e.g. the consumer payment record). The claimed system is not further discussed in this section of the brief to avoid unnecessary redundancy.

Claim 28 is directed to a computer implemented method for payment remittance processing which requires that a database (e.g. merchant database 18) be established to have a plurality of payee records (e.g. records 1-N in Figure 4) associated with a plurality of payees. Each payee record includes stored name information and stored address information, including a zip code, of its associated payee as has been discussed above. Payee name information and payee address information, including a zip code, are received (e.g. as part of a consumer payment record) as also discussed above. A determination is made (e.g. in step 62 of Figure 3 by the RPP 3, as described on page 18, lines 21-24) as to whether the stored payee name information and the stored payee address information included in any of the plurality of payee records (e.g. records 1-N in Figure 4) correspond to the received payee name information and the received payee address information (e.g. the merchant id received as part of a consumer payment record as described on page 18, lines 4-6). If so, payment is directed (e.g. in step 64 of Figure 3 by the RPP 3, as described on page 18, line 25, through page 19, line 1) in accordance with a first of the plurality of payee records (e.g. records 1-N in Figure 4) having the stored payee name information (e.g. stored in merchant database 18) and the stored payee address information (e.g. stored in merchant database 18) which is determined to correspond to the received payee name information (e.g. received as part of the consumer payment record) and the received payee address information (e.g. received as part of the consumer payment record). If not, the received payee address information (e.g. received as part of the consumer payment record) is processed to identify an eleven digit zip code. A determination is made (e.g. in step 66 of Figure 3 by RPP 3, as described on page 19, lines 5-17) as to whether the stored payee zip code included in any of the plurality of payee records (e.g. records 1-N in Figure 4) corresponds to the identified eleven-digit zip code (e.g. zip code 82 of Figure 4). If so, payment is directed (e.g. in step 64 of Figure 3 by the RPP 3, as described on page 3, lines 14-15) in accordance with a second of the plurality of

payee records (e.g. records 1-N in Figure 4) having the stored payee zip code (e.g. stored in merchant database 18) which is determined to correspond to the identified eleven-digit zip code (e.g. zip code 82).

VI. ISSUES

Whether claims 1-11 and 13-28 are obvious under 35 USC § 103(a) over Kight et. al. (U.S. Patent No. 5,383,113) in view of Pintsov et. al. (U.S. Patent No. 5,612,889).

VII. BRIEF DESCRIPTION OF THE REFERENCES

A) Kight et. al. (U.S. Patent No. 5,383,113)

Kight et. al., which is commonly assigned to the assignee of all rights in the present application, discloses a system (shown in Figure 1) which allows a payor to direct payment of bills of a plurality of different payees (e.g. billers) through a service provider (column 3, line 55, through column 4, line 2). The system, including elements 40, 46, and 50, is accessed directly by the payor via a remote communications device 35 or 37 (column 3, line 67, through column 4, line 2). Once connection with the system has been established, the payor directs the system to make payments to individual payees (column 3, lines 57-59). Payment directions for paying payees are generated in accordance with payment requests (column 4, lines 42-56). Kight ensures that payments to payees are in a proper payment format (column 3, line 39). In a described service initiation process, the individual payor prepares and directly files a form with the service provider which provides the necessary information relating to that payor (Col. 2, lines 38-53). Thus, Kight discloses that payors direct the payment of bills from different payees by transmitting payment requests to the service provider. Kight, in columns 3, lines 4-9 and 7, lines 10-12, generally discloses the need for validation of the bank and payee account numbers, but does not disclose any particulars as to how these validations are performed.

B) Pintsov et. al. (U.S. Patent No. 5,612,889)

According to Pintsov and as described in column 11, line 52, through column 13, line 30, a mailer forwards a mailing file 120 (shown in Figure 2) to a carrier service (e.g. a mail delivery service). The carrier service generates a mailing identification file 122 that includes a unique mail ID 306 (which, as shown in Figure 3, does not include a zip code) for each mail piece in the mailing file 120 and forwards file 122 to the mailer for an address character number check. The unique mail ID 306 is then printed on a piece of mail 104a, shown in Figure 6, sent to the carrier service by the mailer. The carrier service accesses the mail identification file 122 (Figure 3) and the mail processing file 124 (Figure 4) using the unique mail ID 306 printed on the mail piece. The mail identification file 122 is accessed using this unique mail ID 306 to ensure that the unique mail ID 306 printed on the mail piece matches with a unique ID 306 in the file 122 and to retrieve any address correction information. Hence, file 122 is accessed using the unique ID 306 (not a zip code) and information in file 122 is retrieved based on its correspondence with the unique ID 306 (not a zip code). The mail processing file 124 is accessed using this unique mail ID 306 to retrieve the correct delivery point postal code 402 (the recipient's original or modified address) which corresponds to the unique ID 306 printed on the mail piece 104a. The retrieved delivery point postal code 402 is printed on the mail piece 104a as code 1002 shown in Figure 10. Hence, file 124 is also accessed using the unique ID 306 (not a zip code) and information in file 124 is also retrieved based on its correspondence with the unique ID 306 (not a zip code). The mail piece 104a of Figure 10 can then be delivered to the recipient.

The unique mail ID 306 may also be used by the carrier service to charge the mailer's debit account. Hence, in Pintsov the mailer is the payor and the carrier service is the payee/merchant.

Thus, Pintsov et. al. discloses a mail system for securely protecting payment to the carrier service by ensuring that the

carrier service authorizes mail prior to its actual deposit into the postal stream. As described in column 12, line 51, through column 13, line 30, and shown in Figures 6 and 10, each mail piece is marked with a unique mail piece ID 306 (which as noted above is explicitly disclosed not to be a zip code). The printed unique ID 306 is used in the authorization process. In this regard, the unique mail piece ID 306 printed on the mail piece 104a is used to access the correct information in the mailing files 122 and 124 (shown in Figures 3 and 4) to ultimately retrieve the extended zip code 402 (shown in Figure 4). The extended zip code 402 is then printed on the mail piece 104a as indicated by reference numeral 1002, and used to identify the delivery point to which delivery is made (column 11, lines 39-51).

The stored extended zip code 402 may be altered due to an address change (column 7, lines 49-56, column 10, lines 61-65, column 11, lines 56-67 and column 12, lines 1-4). Information is processed to debit the mailer's account, and a mailing ID file is sent to the mailer after the debiting of the mailer's account (column 10, lines 54-55).

VIII. THE REJECTION

Claims 1-11 and 13-28 stand finally rejected under 35 USC § 103(a) as obvious over Kight et. al. (U.S. Patent No. 5,383,113) in view of Pintsov et. al. (U.S. Patent No. 5,612,889). The rejections are detailed in a non-final Official Action dated May 20, 1999 and a Final Official Action dated June 9, 2000.

With regard to independent claims 1, 11, and 16, the Examiner acknowledges that Kight fails to disclose the required processing of the payment information, other than a received zip code, to identify an eleven digit zip code which is used to access a database to locate or retrieve a payee record having a corresponding associated zip code, and points to Pintsov (column 7, lines 49-52) as teaching the processing of mail information to identify an eleven digit zip code. On this basis, the Examiner concludes that it was obvious to process payment information to

identify an eleven digit zip code and to access or retrieve a payee record based on the identified zip code.

With regard to independent claims 10 and 22, the Examiner points to Pintsov (column 13, lines 55-59) as making obvious the recited processing to identify an eleven digit zip code in order to deliver payment to the correct entity regardless of changes in the entity's address. The Examiner argues that Pintsov discloses a unique code that identifies an eleven digit delivery address (citing column 11, lines 26-29 and 49-51). The Examiner asserts, without providing any supporting rationale, that in view of this teaching it was obvious to use an eleven digit zip code to access payee records because the code identifies where the payment should be made and is associated with a specific payee.

The Examiner further relies on Pintsov's use of a unique identifier (i.e. mail piece ID 306) which is associated with each address, and the fact that each address has a zip code, as suggesting the recited accessing of a database of payee or merchant records, to locate the payee or merchant records corresponding to an identified zip code. The Examiner also relies on Kight in column 3, lines 32-34, as disclosing the inclusion of a name and address in the payment information and Pintsov as disclosing that the unique identifier (i.e. mail piece ID 306) serves as the mailer's identification, which in the postal industry is the mailer's name and address, as suggesting the processing of a merchant's name, city and state information to identify a zip code which is used to access a database of merchant records to locate a merchant record corresponding to the identified zip code, as recited in claim 10.

With regard to claims 1-4, 6-11, 13-18 and 20-26, the Examiner points to Pintsov, in column 12, lines 23-32, as disclosing postage information, which the Examiner considers equivalent to the recited payment information, and the debiting of postage to the mailer's account, which the Examiner considers equivalent to the recited payee record. The Examiner goes on to assert that the mailer's account forms part of a file which includes a list of addresses having zip codes associated with

each address.   The Examiner considers this equivalent to the required database of payee records (as, for example, recited in independent claims 1, 16 and 22) or the required stored payee records (as, for example, recited in independent claim 11).

The Examiner further states that Pintsov, in column 10, lines 54-55, discloses that the mail piece ID 306 is associated with each address and each address has a zip code.   This disclosure is relied on by the Examiner as suggesting (i) the recited processing of payment information (which in the case of independent claims 1, 11 and 16 excludes the payee zip code), to identify or produce a zip code, and (ii) the recited accessing of a database of payee records (which in the case of claims 1, 11 and 16 each include a zip code), to locate the desired payee record corresponding to the identified zip code, or the recited retrieval from such a database of the payee record(s) which correspond to the produced zip code.   The Examiner also asserts that it is old and well known to access a database to locate payee information.

With regard to claims 5, 19 and 27, the Examiner takes Official Notice that it is well known to locate a payee record by matching, and on this basis concludes that the combination of Kight, Pintsov and this Official Notice made it obvious to locate a payee record by matching (i) an identified eleven digit zip code with a zip code in the database of payee records and (ii) a portion of a received payee name with a portion of a payee name in the database of payee records. The Examiner further asserts that one would have been motivated to perform such matching because this information is part of the payee's account which is unique to the applicable payee.

With respect to claims 8, 14 and 20, the Examiner points to Kight (column 3, lines 4-9) as disclosing verifying an account number and transforming the verified account number. The Examiner acknowledges that Kight fails to teach validation rules, and points to Pintsov (column 10, lines 61-65, column 11, lines 56-67, and column 12, lines 1-4) as teaching a unique identifier with an error correction code and a validation process.

The Examiner acknowledges that Kight discloses only the
verification of a bank account number (and not a payee account
number) in the referenced text, but contends that this is
equivalent to the recited validation of the payee account number
according to validation rules corresponding to payee values for
fields of the account number. The Examiner also points out that
Kight, in column 7, lines 10-12, discloses validation of a
merchant's account.

The Examiner, while acknowledging that Pintsov's fails to
disclose what the described error correction is used for, asserts
that Pintsov's disclosure of an undefined encryption validation
process in column 11, line 56, through column 12, line 4,
validates the mailer identification file, including an account
number, and contends that this is equivalent to the recited
validation of the payee account number according to validation
rules corresponding to payee values for fields of the account
number.

With regard to claims 9, 15, 21 and 24, the Examiner
acknowledges that Kight fails to teach identifying one of a
plurality of remittance centers, and points to Pintsov (column
11, lines 39-51) as disclosing the use of a zip code to identify
a single delivery point to which delivery is directed. The
Examiner asserts that, in the referenced text, Pintsov discloses
mailing files that include a mailer account number and are
accessed to retrieve a destination delivery code. The Examiner
further contends that even though the mailer's account (not the
merchant's account) is used by Pintsov, all steps for the
identification are disclosed.

With regard to claim 23, the Examiner further acknowledges
that Kight fails to disclose transformation of an account number
based upon alteration rules, and points to Pintsov (column 10,
lines 61-65, and column 7, lines 49-52) as teaching a unique
identification number having a specific format and transforming
mail address codes into new delivery point postal codes. On this
basis the Examiner concludes that it was obvious to format
account numbers in accordance with alteration rules in order to

make sure that the payment is from the correct payer. The Examiner further contends that Pintsov, in column 10, lines 61-65, discloses that each mailing file includes a unique ID (associated with an account code and having a specific format) and addresses listed in the file. The Examiner also asserts that Pintsov discloses altering the zip code due to an address change, and that the format of the unique identifier will change depending on the mailer because the mail piece count 312 and the number of address characters 314 will be different for each mailer on the mailing list.

With regard to claim 28, the Examiner points to Kight column 2, lines 5-11 and 40-45, and Pintsov column 11, line 52, through column 12, line 12, as disclosing all recited features, including the alternative directing of payments based on either the correspondence of (i) payee name and address information or (ii) payee zip code information. The Examiner further asserts that one would have been motivated to perform such alternative directing of payments because, in order for payment remittance processing to occur without error, there needs to be some type of validation process which will make sure that the correct person is getting paid at the correct address.

In the Advisory Action dated January 25, 2001, the Examiner replies to the Request for Reconsideration filed September 29, 2000 and Notice of Appeal filed December 11, 2000, by stating that "The unique mail ID in the Pintsov reference serves the same purpose as the zip code of the present invention which is to access stored records. Besides, a zip code is nothing more than a unique mail ID."

IX. GROUPING OF CLAIMS

The various claimed embodiments of the invention are defined within groupings of claims (i) 1-9, (ii) 10, (iii) 11 and 13-15, (iv) 16-21, (v) 22-27, and (vi) 28. However, the claims of each group do not stand or fall together. Claims (i) 1-4 and 6-7, (ii) 5, (iii) 8, (iv) 9, (v) 10, (vi) 11 and 13, (vii) 14, (viii) 15 (ix) 16-18, (x) 19, (xi) 20, (xii) 21, (xiii) 22 and 25-26,

(xiv) 23, (xv) 24, (xvi) 27, and (xvii) 28 each require features which form an independent basis for allowance.

X. ARGUMENT

Appellants respectfully traverse the rejections based on the prior art combination applied against the claims now pending on appeal. As discussed below, it is respectfully submitted that the Examiner has not met the burden of proof in establishing that the appealed claims are obvious, has failed to provide the required factual basis and reasonable rational for the rejections, and has failed to apply art which teaches or suggest the invention as claimed.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). No claim limitation, including one which is functional, can be ignored. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). All words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of

what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Hindsight after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must disclose doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

With regard to independent claims 1, 10, 11, 16 and 22 and their dependencies (i.e. claim 1 dependencies 2-4 and 6-9, claim 11 dependencies 13-15, claim 16 dependencies 17-18 and 20-21, and claim 22 dependencies 23-26), the Examiner contends that Pintsov in column 12, lines 23-32, discloses that postage information, which the Examiner considers equivalent to the recited payment information, is debited to the mailer's account, which the Examiner considers equivalent to the recited payee record. The Examiner further asserts that the mailer's account forms part of a file including a list of addresses having zip codes associated with each address, which the Examiner considers equivalent to the database of payee records (as, for example, recited in independent claims 1, 16 and 22) or the stored payee records (as, for example, recited in independent claim 11).

However, the referenced text in Pintsov relates to payment by the mailer to the carrier service. Thus, contrary to the Examiner's contention, the account described in the referenced text is a debit account of the mailer, who is the payor (not the payee). Accordingly, the Examiner has construed the reference in a manner inconsistent with its own teachings.

In the case of Pintsov, the payee is the carrier service. Additionally, the mailer's debit account is taught by Pintsov to be associated with the unique identifier. Although it is true that the unique identifier is also associated with the mail records, there is nothing within Pintsov to suggest that the debit account is part of the mail record. Rather, in discussing the mailer's debit account on column 12, lines 25-30, Pintsov fails to in any way suggest that this account is identified in the mail record. Nor is there any suggestion in Pintsov's discussion of the files shown in Figures 2-4, that the account numbers 202 and 302 are other than the mailer's account number with the carrier service. Nor is there any suggestion in Pintsov that any other number referenced in the depicted files is the mailer's debit account number. Accordingly, the Examiner has based the rejection on mere speculation and without any reasonable objective support.

The Examiner goes on to state that Pintsov in column 10, lines 54-55, discloses that the mail piece ID 306 is associated with each address and each address has a zip code. This disclosure is relied on by the Examiner as suggesting (i) the recited processing of payment information (which in the case of independent claims 1, 11 and 16 excludes the payee zip code), to identify or produce a zip code, and (ii) the recited accessing of a database of payee records (which in the case of independent claims 1, 11 and 16 each include a zip code), to locate the desired payee record corresponding to the identified zip code, or the recited retrieval from such a database of the payee record(s) which correspond to the produced zip code. The Examiner in a prior non-final Official Action also relied on Pintsov, column 7, lines 49-52, in support of the rejection.

However, to the extent Pintsov discloses processing payment information in the referenced text, such processing would have nothing whatsoever to do with identifying a zip code. Rather, what the Examiner construes as payment information is processed only to debit the mailer's account. At best this corresponds to generating a payment request. Hence, here again, the Examiner has

applied the reference in a manner inconsistent with its own teachings.

The discussion of the mailing ID file 122 in the referenced text in column 10 is also unrelated to the processing of what the Examiner construes as payment information, except to the extent that the file 122 is only sent to the mailer after the debiting of the mailer's account. Furthermore, there is no identifying of a zip code based on the relied upon processing. Thus, the Examiner again fails to provide any reasonable objective support for the rejection.

In the referenced text, Pintsov also discloses altering the stored zip code due to an address change. However, here again the received information is not used to identify a zip code, which is in turn used to access or retrieve file information. Rather, Pintsov uses a unique ID other than the zip code (see for example Figure 6 and column 12, line 51, through column 13, line 15) to access a stored file to obtain an extended zip code and prints the extended zip code on a piece of mail. The unique ID is also, when appropriate, used to access a stored change of address to obtain a changed zip code, which is substituted for the original zip code in the stored file. Accordingly, the Examiner has relied upon a construction of the reference which is unsupported by the reference itself and in inconsistent with the reference's own teachings.

The Examiner takes Official Notice that it is old and well known to access a database to locate payee information but provides no further insight into how this is relevant to the present claims. In this regard, even if this is true, the claims recite using a zip code for accessing data to locate or retrieve payee information corresponding to the zip code. Further, the claims require processing other received information to identify the zip code which is used to locate or retrieve the payee information which has an associated corresponding zip code. Accordingly, it is not possible for the Applicants to understand the relevance of the Official Notice taken by the Examiner and

hence the basis of the rejection of the claims in reliance on the Official Notice.

As clearly indicated in Figure 4 of Pintsov, and the related descriptive text, Pintsov uses a received unique identifier 306 (which, as shown in Figure 3, does not include zip codes) to access zip code and other data associated with a corresponding unique identifier. The Examiner has not identified any teaching or suggestion within the applied combination of references, and it is respectfully submitted that there is no such teaching or suggestion, which would motivate one skilled in the art to modify Pintsov to locate or retrieve data based on its association with a zip code rather than Pintsov's unique identifier (which is explicitly taught to be other than a zip code), let alone a zip code which corresponds to a zip code identified from received information, as recited in each of the pending independent claims (i.e. claims 1, 10, 11, 16, 22 and 28). Hence, even if the applied art combination disclosed locating or retrieving data based on its association with a zip code which corresponds to a zip code identified from received information as required by the present claims (which it is respectfully submitted is not the case), the Examiner has failed to provide any reasonable evidence from within the applied references, or otherwise, that one would be motivated to modify Pintsov to incorporate such features or that there would be any advantage or benefit in doing so.

With respect to independent claims 10 and 22, the Examiner initially pointed to Pintsov (column 11, lines 26-29 and 49-51 and column 13, lines 55-59) as making obvious the recited processing to identify an eleven digit zip code in order to deliver payment to the correct entity regardless of changes in the entity's address. The Examiner, later relied on Pintsov's use of a unique identifier (i.e. mail piece ID 306) which is associated with each address, and the fact that each address has a zip code, as suggesting the recited accessing of a database of payee or merchant records, to locate the payee or merchant records corresponding to an identified zip code.

The Examiner also relies on Kight's disclosure in column 3,

lines 32-34, that the payment information includes a name and address and Pintsov's disclosure that the unique identifier (i.e. mail piece ID 306) serves as the mailer's identification, which in the postal industry is the mailer's name and address, as suggesting the processing of a merchant's name, city and state information to identify a zip code which is used to access a database of merchant records to locate a merchant record corresponding to the identified zip code as recited in claim 10.

However, contrary to the Examiner's assertion, Pintsov lacks any teaching or suggestion of using an identified zip code to access a database as recited. Rather, Pintsov expressly teaches using a received unique identifier, other than the zip code, to access files having a stored record to obtain a zip code or changed zip code. Even if the Pintsov's unique ID could somehow be construed to correspond to a merchant's name, city and state information (which it is respectfully submitted would be improper), in accordance with Pintsov it would necessarily be this name, city and state information which would be used to access a database of records to locate a record with the desired zip code. The Examiner has failed to identify any disclosure within Pintsov or Kight (and it is respectfully submitted that no such disclosure exists) suggesting, even if the name, city and state information were substituted for Pintsov's unique ID, that this information should be processed to identify a zip code which is then used to access a database of records to locate a record associated with a corresponding zip code. In fact, Pintsov has no reason to identify a zip code and then use it for accessing a database, since the reason that Pintsov accesses the file is to obtain the zip code. That is, in Pintsov the zip code is the data which is being accessed. Accordingly, the Examiner has again relied upon a construction of the reference which is unsupported by the reference itself and is inconsistent with the reference's own teachings.

Independent claim 28 requires that it be determined if stored payee name and payee address information included in any of the plurality of payee records corresponds to received payee

name and payee address information.

Also required is that (i) if the stored payee name and payee address information included in a first payee record is determined to correspond to the received payee name and payee address information, payment is directed in accordance with this first record, and (ii) if none of the plurality of payee records include stored payee name and payee address information which is determined to correspond to the received payee name and payee address information, the received payee address information is processed to identify an eleven digit zip code, a determination is made if a stored payee zip code included in any of the plurality of payee records corresponds to the identified zip code, and payment is directed in accordance with a second of the plurality of payee records if the stored payee zip code included in the second payee record is determined to correspond to the identified zip code.

The Examiner points to Kight column 2, lines 5-11 and 40-45, and Pintsov column 11, line 52, through column 12, line 12, as disclosing all recited features of claim 28. The Examiner further argues that one would have been motivated to perform such alternative directing of payments because, in order for payment remittance processing to occur without error, there needs to be some type of validation process which will make sure that the correct person is getting paid at the correct address.

However, contrary to the Examiner's assertion, the referenced Pintsov disclosure relates to the matching of (i) data in the mailer's mailing file 120 (Figure 2) with (ii) data in the mailing identification file 122 (Figure 3) created by the carrier service, to confirm that the data in the mailing identification file 122 is correct before the unique ID 306 is printed on the mail piece. The matched data is the address data for the intended recipients of mail piece. Pintsov further discloses that the payee is the carrier service. Hence, the Examiner's assertion that Pintsov suggests that the matched data include payee name and address information is inconsistent with the explicit teachings of the reference itself, since Pintsov's

matching clearly has nothing whatsoever to do with the name and address of the payee carrier service.

Further, Pintsov discloses only one match to confirm the correctness of the data, i.e. a match of the number of characters in each address in the mailing file 120 with the address character number 314 in the mailing identification file 122. Accordingly, the Examiner's contention that Pintsov suggests the required alternative matching is entirely unsupported by Pintsov and hence the applied combination of art.

Moreover, the Examiner's contention that Pintsov suggests that (i) if a first correspondence is determined based on the received name and address information, payment is directed in accordance with a first record, and (ii) if not, and a second correspondence is determined based on a zip code identified by processing the received address information, payment is directed in accordance with a second record, is also totally unsupported by any reasonable reading of Pintsov, and hence by the applied art in combination. In fact, Pintsov is incapable of accommodating such alternatives, since Pintsov requires that the number of characters in the name, address and zip code 204 match with the number of characters 314 or processing stops.

With regard to claims 5, 19 and 27, the Examiner takes Official Notice that it is well known to locate a payee record by matching, and on this basis concludes that the combination of Kight, Pintsov and this Official Notice made it obvious to locate a payee record by matching (i) an identified eleven digit zip code with a zip code in the database of payee records and (ii) a portion of a received payee name with a portion of a payee name in the database of payee records. The Examiner further argues that one would have been motivated to perform such matching because this information is part of the payee's account which is unique to the applicable payee.

As discussed above, Pintsov, in column 12, line 51, through column 13, line 30, teaches that a unique ID 306, which is explicitly disclosed as not including a name, address or zip code should be used to access the files from which the correct

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extended zip code 402 for an intended recipient is retrieved. Thus, Pintsov explicitly teaches locating a record by matching a unique ID (which does not include a name, address or zip code) with an identical ID 306 in the record 122 or 124 to identify a zip code 402. Therefore Pintsov clearly teaches against matching a zip code with the zip code 402 in the records 122 and 124 and matching a portion of a name with a portion of the name 304 in the records 122 and 124. Accordingly, Pintsov's teachings are inconsistent with the Examiner's asserted position.

Further, even if Pintsov could be properly construed to disclose matching a portion of the name or zip code in 304 or 402 (which it is respectfully submitted is not the case), the zip code and name being matched would be that of the intended mail recipient and not the payee (who as noted above is the carrier service). Accordingly, here again, Pintsov's teachings are inconsistent with the Examiner's position.

With regard to claims 8, 14 and 20, in a non-final Official Action, the Examiner relied on Kight (column 3, lines 4-9) as disclosing verifying an account number and transforming the verified account number. As noted in the response to that Official Action, Kight's disclosure in referenced text relates to verifying a bank account number and not to verifying a merchant account number as recited in the present claims. The Examiner, while now acknowledging that Kight discloses only the verification of a bank account number (and not a merchant account number) in the referenced text, contends that this is equivalent to the recited validation of the payee account number according to validation rules corresponding to payee values for fields of the account number in support of the final rejection of the above claims. The Examiner also points out that Kight, in column 7, lines 10-12, does disclose validation of a merchant's account.

Although it is acknowledged that Kight, in column 3, lines 4-9, and column 7, lines 10-12, does generally disclose the need for validation of the bank and payee account numbers, Kight does not disclose any particulars as to how these validations are performed. Further, there is nothing in Kight to suggest that

the bank account number and the payee account number should or could be validated in the same way. Hence, the Examiner's assertion that Kight suggests that the payee account number is validated in accordance with validation rules corresponding to payee values for fields of the account number, is without support and can only be based on mere speculation.

In a non-final Official Action, the Examiner also pointed to Pintsov (column 10, lines 61-65, column 11, lines 56-67, and column 12, lines 1-4) as teaching a unique identifier with an error correction code and a validation process. However, as noted in the response to that non-final Official Action, Pintsov fails to disclose what the referenced error correction code is used for. The Examiner, while now acknowledging that Pintsov fails to disclose what the described error correction is used for, asserts that Pintsov's disclosure of an undefined encryption validation process in column 11, line 56, through column 12, line 4, validates the mailer identification file, including an account number, and contends that this is equivalent to the recited validation of the payee account number according to validation rules corresponding to payee values for fields of the account number.

Although it is acknowledged that Pintsov does disclose a simple encryption validation process, the Examiner's contention that Pintsov teaches or suggests validating an account number based on validation rules corresponding to values for fields of the account number is entirely unsupported by Pintsov's disclosure.

In fact, Pintsov's account number 302 is never validated. Rather, as described in the referenced text only the addresses 304 in the mailing identification file 122 are validated by matching the number of characters in each address 304 to the applicable numeric in the unique ID 306. Hence, the Examiner's position is also inconsistent with the teachings of the reference itself.

With regard to claims 9, 15, 21 and 24, in a non-final Official Action the Examiner acknowledged that Kight fails to

teach identifying one of a plurality of remittance centers, but pointed to Pintsov (column 11, lines 39-51) as disclosing the use of a zip code to identify a single delivery point to which delivery is directed. However, as noted in the response to that non-final Official Action, Pintsov lacks any disclosure of using an account number to identify one of a plurality of different delivery points associated with a single entity as required by the present claims.   In the final Official Action, the Examiner, presumably continuing to rely on the disclosure in column 11, lines 39-51, contends that Pintsov discloses mailing files that include a mailer account number and that these files are accessed to retrieve a destination delivery code.   The Examiner further asserts that even though the mailer's account (not the payee's account) is used by Pintsov, all steps for the identification are disclosed.

However, the applicable claims require that a single payee have a plurality of remittance centers and that an account number be processed to identify a single one of the plurality of remittance centers to which payment for that payee is to be directed.   Pintsov lacks any disclosure whatsoever of processing an account number, let alone processing an account number to determine a destination address of the recipient.   Rather, it appears that the only account number disclosed by Pintsov (i.e. account number 302) simply identifies the mailer.   Accordingly, the Examiner's rationale is not understandable.   Further, the Examiner's position is unsupported by the referenced disclosure.

Additionally, even if Pintsov's unique ID were to be considered to correspond to an account number (which it is respectfully submitted is not supported by the applied art), the unique ID identifies the addresses of the intended recipients of the mail pieces (who are not payees in Pintsov), and not the carrier carrier service, which is the only payee in Pintsov. Accordingly, the Examiner's position is inconsistent with the teaching of the applied art itself.

Further still, according to Pintsov, the unique ID is selected to identify only a single address.   Hence, there is

absolutely no need to process a unique ID to identify which one of multiple addresses a mail piece should be directed to. Thus, the Examiner's proposed modifications to the applied art are unmotivated by the applied teachings or otherwise.

Claim 23 requires that a payor account number be transformed according to alteration rules indicative of a format of account numbers of the payee.

In a non-final Official Action the Examiner acknowledged Kight's failure to disclose the transformation of an account number based upon alteration rules, but pointed to Pintsov (column 10, lines 61-65 and column 7, lines 49-52) as teaching a unique identification number having a specific format and transforming mail address codes into new delivery point postal codes. On this basis the Examiner concluded that it was obvious to format account numbers in accordance with alteration rules in order to make sure that the payment is from the correct payer. However, as discussed in the response to that non-final Official Action, Pintsov lacks any disclosure of altering the unique identification number. What Pintsov does disclose is altering the extended zip code due to an address change. Hence, Pintsov's alteration might be used, in modified form, with the present invention to update the merchant database, but fails to make obvious the recited alteration of the account number.

The Examiner in the Final Official Action contends that Pintsov in column 10, lines 61-65, discloses that each mailing file includes a unique ID (associated with an account code and having a specific format) and addresses listed in the file. The Examiner also contends that Pintsov discloses altering the zip code due to an address change, and that the format of the unique identifier will change depending on the mailer because the mail piece count 312 and the number of address characters 314 will be different for each mailer on the mailing list.

However, the only account number disclosed by Pintsov (i.e. mailer account number 302), is not disclosed by Pintsov to be altered in any way. Accordingly, the Examiner's position is unsupported by the relied upon art.

Further, even if the unique ID 402 were to be considered an account number (which it is respectfully submitted would be improper as well as inconsistent with other positions taken by the Examiner), although the content of the ID may change as discussed in column 10, lines 61-65, there is nothing within Pintsov to suggest that the format as shown in Figures 3 and 4, could be, let alone would be changed. Rather, it is clear from Pintsov's disclosure that altering the zip code 404 due to a change in the address 304, the mail piece count 312 and/or the number of address characters 314 will have no effect whatsoever on the format of the unique ID 306. Thus, the Examiner's position is inconsistent with the teachings of Pintsov.

Furthermore, there is nothing in Pintsov to suggest that a received unique ID is somehow processed and altered. Rather, implicit in Pintsov is that received unique ID, which is used to access the corresponding mail processing file to retrieve the deliver point postal code, should not be modified, since this would lead to an improper deliver point postal code being retrieved. Therefore, the Examiner's position in this regard is also inconsistent with the teachings of Pintsov.

MPEP §706.07 clearly requires that "before final rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be _fully applied_" (emphasis added), so as to deal justly with the applicant as well as the public. The Manual goes on to state that "present practice does not sanction hasty and ill-considered final rejections". "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end." "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

In the present instance, pending claims 1-11 and 13-28 were rejected over prior art on the basis of a reading of the prior

art which is inconsistent with the art's own teachings, and without a clear explanation of the rational, or support for the rejection. Further, it is respectfully submitted that the Examiner has rejected the claims without consideration of recited features, without reasonably considering what is taught and suggested by the applied reference, and at best based on an improper hindsight reconstruction of the claimed invention. Notwithstanding the Applicant's attempts to obtain an understanding of the basis for the rejection, the rejection of the claims over the prior art has been maintained, as indicated in the Advisory Action of January 25, 2001 in contradiction of MPEP 706.07.

Hence, it is apparent that the Examiner has failed to comply with the requirements of MPEP 706.07 and has not established a prima facie basis for the rejection of the claims 1-11 and 13-28 in the Final Official Action.

2.   THE APPLIED REFERENCES FAIL TO TEACH OR SUGGEST THE CLAIMED INVENTION

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966), **and** to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such a reason must stem from some teaching,

suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436,

230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 208 USPQ 817 (CCPA 1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

The issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), In re Keller, supra. See In re Laskowski, F2d., 10 USPQ2d 1397 (CAFC 1989).

Claims 1-11 and 13-28 stand rejected under 35 USC § 103(a) as obvious over Kight et. al. (U.S. Patent No. 5,383,113) in view of Pintsov et al. (U.S. Patent No. 5,612,889). The rejection is respectfully traversed.

With regard to independent claims 1, 11 and 16, the Examiner acknowledges that Kight fails to disclose the required processing of the payment information, other than a received zip code, to identify an eleven digit zip code which is used to access a database to locate or retrieve a payee record having a

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corresponding associated zip code. The Examiner points to
Pintsov (column 7, lines 49-52) as teaching the processing of
mail information to identify an eleven digit zip code. On this
basis, the Examiner contends that it was obvious to process
payment information to identify an eleven digit zip code and, as
understood, to access or retrieve a payee record based on the
identified zip code.

Contrary to the Examiner's position, Pintsov lacks any
disclosure of processing payment information (excluding a
received zip code) to identify a correct zip code which is used
to access a record. Rather, what Pintsov does disclose in the
referenced text is altering the stored zip code due to an address
change. Hence, Pintsov's alterations could be used in
conjunction with present invention to update the merchant
database, but clearly fails to make obvious the recited
processing of information to identify a zip code which is used to
access a record.

Further, Pintsov is directed to a mail system for securely
protecting the payment to the carrier service by insuring that
the carrier service authorizes mail prior to its actual deposit
into the postal stream. Each mail piece is marked with a mail
piece ID 306 (see Figure 6) other than the zip code, which is
used in the authorization process. As disclosed in column 12,
lines 51+, the unique mail piece ID is used to access the correct
mailing identification file to, as discussed in column 13, lines
8-15, retrieve the extended zip code. As discussed in column 13,
lines 22-26, the zip code is then printed on the mail piece as
indicated by 1002 of Figure 10 (see column 13, lines 27-30).

Hence, the applied combination lacks any teaching or
suggestion of using a zip code, which is identified by processing
information excluding a received zip code, to locate or retrieve
a file or record which has an associated corresponding zip code.
Rather, the combination at best suggests using a unique ID, other
than a zip code, to access a stored record having a corresponding
unique ID to obtain a zip code and printing the zip code on a
piece of mail, and, if appropriate, using the unique ID to access

a stored change of address record having a corresponding unique ID to obtain a changed zip code and substituting the changed zip code for the original zip code in the stored record.

With regard to independent claims 10 and 22, the Examiner points to Pintsov (column 13, lines 55-59) as making obvious the recited processing to identify an eleven digit zip code in order to deliver payment to the correct entity regardless of changes in the entity's address.

However, contrary to the Examiner's position, Pintsov lacks any teaching or suggestion of using the identified zip code to access a database as recited. Rather, as discussed above, Pintsov uses a unique identifier, other than the zip code, to access files.

The Examiner points to Pintsov as disclosing a unique code that identifies an eleven digit delivery address (citing column 11, lines 26-29 and 49-51), and asserts, without providing any supporting rationale, that in view of this teaching it was obvious to use an eleven digit zip code to access payee records because the code identifies where the payment should be made and is associated with a specific payee. However, as noted above, Pintsov lacks any teaching or suggestion whatsoever of using a zip code to access records. Rather, Pintsov teaches accessing records using a unique code (which is expressly taught not to be a zip code) to obtain the zip code and therefore teaches against accessing records using a zip code.

Hence, the applied combination of references at best teach or suggest accessing a stored record to obtain a zip code using a unique ID other than the zip code and, to the extent appropriate, accessing a stored change of address record to obtain a changed zip code using this unique ID and substituting the changed zip code for the original zip code in the stored record. The applied art also lacks any teaching or suggestion of using the name, city and state to identify the zip code.

With regard to claims 1-4, 6-11, 13-18 and 20-26, the Examiner, further contends that Pintsov, in column 12, lines 23-32, discloses postage information, which the Examiner asserts is

equivalent to the recited payment information. The postage is debited to the mailer's account, which the Examiner asserts is equivalent to the recited payee record. The Examiner further contends that the mailer's account forms part of a file including a list of addresses having zip codes associated with each address, which the Examiner considers equivalent to the database of payee records (as, for example, recited in independent claims 1, 16 and 22) or the stored payee records (as, for example, recited in independent claim 11).

However, the referenced text relates to payment by the mailer to the carrier service. Contrary to the Examiner's contention, the account described in the referenced text is a debit account of the mailer, who is the payor, and accordingly is by no means equivalent to the recited payee record. As discussed above, in the case of Pintsov, the payee is the carrier service.

Additionally, the mailer's debit account is taught by Pintsov to be associated with the unique identifier. Although it is true that the unique identifier is also associated with the mail records, there is nothing within Pintsov to suggest that the debit account is part of the mail record. Rather, in discussing the mailer's debit account in column 12, lines 25-30, Pintsov fails to in any way suggest that this account is identified in the mail record.

Nor is there any suggestion in Pintsov's discussion of the files shown in Figures 2-4, that the account numbers 202 and 302 are other than the mailer's account number with the carrier service. Nor is there any suggestion in Pintsov that any other number referenced in the depicted files is the mailer's debit account number.

The Examiner further states that Pintsov in column 10, lines 54-55, discloses that the mail piece ID 306 is associated with each address and each address has a zip code. This disclosure is relied on by the Examiner as suggesting (i) the recited processing of payment information (which in the case of independent claims 1, 11 and 16 excludes the payee zip code), to identify or produce a zip code, and (ii) the recited accessing of

a database of payee records (which in the case of claims 1, 11 and 16 each include a zip code), to locate the desired payee record corresponding to the identified zip code, or the recited retrieval from such a database of the payee record(s) which correspond to the produced zip code.

However, to the extent Pintsov discloses processing payment information in the referenced text, it has nothing whatsoever to do with identifying a zip code. Rather, what the Examiner contends is equivalent to payment information is processed only to debit the mailer's account. At best this corresponds to generating a payment request. The discussion of the mailing ID file 122 in the referenced text in column 10 is unrelated to the processing of that which the Examiner considers equivalent to payment information, except to the extent that the file 122 is only sent to the mailer after the debiting of the mailer's account. Furthermore, there is no identifying of a zip code based on the relied upon processing.

In the referenced text, Pintsov also discloses altering the stored zip code due to an address change. However, here again the received information is not used to identify a zip code, which is in turn used to access or retrieve file information. Rather, Pintsov uses a unique ID other than the zip code (see for example Figure 6 and column 12, line 51, through column 13, line 15) to access a stored file to obtain an extended zip code, and prints the extended zip code on a piece of mail. The unique ID is also, when appropriate, used to access a stored change of address to obtain a changed zip code, which is substituted for the original zip code in the stored file.

The Examiner takes Official Notice that it is old and well known to access a database to locate payee information. However, the claims recite using a zip code for accessing data to locate or retrieve payee information corresponding to the zip code. The fact that it is well known to access a database to locate information is irrelevant. Hence, the Examiner's reliance on the Official Notice is not understood.

Further, the claims require processing other received

information to identify the zip code which is used to locate or retrieve the payee information which has an associated corresponding zip code. This feature appears to have been entirely ignored.

As clearly indicated in Figure 4 of Pintsov, and the related descriptive text, Pintsov uses a unique identifier 306 (which, as shown in Figure 3, does not include zip codes) to access zip code and other data associated with a corresponding unique identifier. The present invention recited in each of independent claims 1, 10, 11, 16, 22 and 28, requires that data be located or retrieved based on it association with a zip code which corresponds to a zip code identified from received information. Hence, unlike Pintsov, and thus the combined art, according to the present invention an identified zip code (and not a unique identifier excluding a zip code) is used to access other data associated with a corresponding zip code. Therefore, according to the present invention, there is no need for special identifiers to be generated or stored to ensure that the correct payee data is accessed in response to a payment request.

With respect to claims 10 and 22, the Examiner, as understood, further argues that Pintsov's use of a unique identifier (i.e. mail piece ID 306) which is associated with each address, and the fact that each address has a zip code, suggests the recited accessing of a database of payee or merchant records, to locate the payee or merchant records corresponding to an identified zip code.

The Examiner also relies on Kight's disclosure in column 3, lines 32-34, that the payment information includes a name and address, and Pintsov's disclosure that the unique identifier (i.e. mail piece ID 306) serves as the mailer's identification, which in the postal industry is the mailer's name and address, as suggesting the processing of a merchant's name, city and state information to identify a zip code which is used to access a database of merchant records to locate a merchant record corresponding to the identified zip code, as recited in claim 10.

However, contrary to the Examiner's position Pintsov, and

hence the proposed combination of art, lacks any teaching or suggestion of using an identified zip code to access a database as recited. Rather, as discussed above, Pintsov uses a unique identifier (which is expressly disclosed not to include a zip code) to access files.

The applied combination of references at best suggests accessing a stored record to obtain a zip code or changed zip code using a unique ID other than the zip code. The applied art also lacks any teaching or suggestion of using the name, city and state to identify the zip code.

With regard to independent claim 28, the Examiner points to Kight column 2, lines 5-11 and 40-45, and Pintsov column 11, line 52, through column 12, line 12, as disclosing all recited features, including the alternative directing of payments based on either the correspondence of (i) payee name and address information or (ii) payee zip code information.

The Examiner further argues that one would have been motivated to perform such alternative directing of payments because, in order for payment remittance processing to occur without error, there needs to be some type of validation process which will make sure that the correct person is getting paid at the correct address.

Claim 28 requires that it be determined if stored payee name and payee address information included in any of the plurality of payee records corresponds to received payee name and payee address information. Also required is that (i) if the stored payee name and payee address information included in the first payee record is determined to correspond to the received payee name and payee address information, payment is directed in accordance with a first of the plurality of payee records, and (ii) if none of the plurality of payee records include stored payee name and payee address information which is determined to correspond to the received payee name and payee address information, the received payee address information is processed to identify an eleven digit zip code, a determination is made if a stored payee zip code included in any of the plurality of payee

records corresponds to the identified zip code, and payment is directed in accordance with a second of the plurality of payee records if the stored payee zip code included in the second payee record is determined to correspond to the identified zip code.

The Pintsov disclosure referenced by the Examiner relates to the matching of (i) data in the mailer's mailing file 120 (Figure 2) with (ii) data in the mailing identification file 122 (Figure 3) created by the carrier service, to confirm that the data in the mailing identification file 122 is correct before the unique ID 306 is printed on the mail piece.

According to Pintsov, the matching is performed on the mailing identification file 122 which is transmitted by the carrier service and received by the mailer, and hence the mailer performs the matching. Further, Pintsov discloses only one match to confirm the correctness of the data, i.e. a match of the number of characters in each address in the mailing file 120 with the address character number 314 in the mailing identification file 122.

Moreover, Pintsov, and hence the proposed combination of art, lacks any suggest that (i) if the stored name and address information included in a first of a plurality of records is determined to correspond to received name and address information, payment be directed in accordance with the first record, and (ii) if none of the plurality of records include stored name and address information which is determined to correspond to the received name and address information, the received address information be processed to identify a zip code, a determination be made if a stored zip code included in any of the plurality of records corresponds to the identified zip code, and payment be directed in accordance with a second of the plurality of records if the stored zip code included in the second record is determined to correspond to the identified zip code. In fact, Pintsov is incapable of accommodating such alternatives, since Pintsov requires that the number of characters in the name, address and zip code 204 match with the number of characters 314 or processing stops.

Thus, Kight modified by Pintsov, would at best suggest (i) if the number of characters in the name and address stored by the service provider in Kight's database records is determined by the payor to correspond to a designated number of characters in the payment request received from the payor, the payor would confirm this to Kight's service provider before proceeding with the processing of the payment request, and (ii) if the number of characters in the name and address stored by the service provider in Kight's database records is determined not to correspond to a designated number of characters in the payment request received from the payor, processing of the payment request would stop.

Hence, unlike in claim 28, there are no alternative matches suggested in the applied art combination, or any disclosure of processing received address information to identify a zip code, determining if a stored zip code included in any of the plurality of records corresponds to the identified zip code, and directing payment in accordance with a second of the plurality of records if the stored zip code included in the second record is determined to correspond to the identified zip code.

With regard to claims 5, 19 and 27, the Examiner takes Official Notice that it is well known to locate a payee record by matching, and on this basis concludes that the combination of Kight, Pintsov and this Official Notice made it obvious to locate a payee record by matching (i) an identified eleven digit zip code with a zip code in the database of payee records and (ii) a portion of a received payee name with a portion of a payee name in the database of payee records. The Examiner further argues that one would have been motivated to perform such matching because this information is part of the payee's account which is unique to the applicable payee.

As discussed above, Pintsov, in column 12, line 51, through column 13, line 30, teaches that a unique ID 306, which is explicitly disclosed as not including a name, address or zip code should be used to access the files from which the correct extended zip code 402 is retrieved. Thus, Pintsov explicitly teaches locating a record by matching a unique ID (which does not

include a name, address or zip code zip code) with an identical ID 306 in the record 122 or 124 to identify a zip code 402.

Therefore Pintsov clearly teaches against matching a zip code with the zip code 402 in the records 122 and 124 and matching a portion of a name with a portion of the name 304 in the records 122 and 124. Further, even if Pintsov disclosed matching a portion of the name or zip code in 304 or 402 (which is clearly not the case), the zip code and name being matched would be that of the recipient and not the payee (who as noted above is the carrier service).

Therefore, the combination of Kight, Pintsov and Official Notice at best suggests that Kight's system be modified to match a unique ID (which does not include the merchant's name, address or zip code zip code) received with the payment request from the payor with a unique ID generated and stored in Kight's database by the payment service provider, to access the database record having the corresponding unique ID to retrieve the payee's zip code and/or the payee name from the accessed record, and to direct payment in accordance with the retrieved name and/or zip code information.

Accordingly, the proposed combination fails to teach or suggest locating a payee record (i) by matching an identified eleven digit zip code with the zip code in the database payee record or (ii) a portion of the received payee name with a portion of the payee name in the database payee record, as required by claim 5; or by comparing a portion of the received payee name with a payee name in the payee record, as required by claims 19 and 27.

With respect to claims 8, 14 and 20, the Examiner points to Kight (column 3, lines 4-9) as disclosing verifying an account number and transforming the verified account number.

However, Kight's disclosure in referenced text relates to verifying a bank account number and not to verifying a merchant account number as recited in the present claims.

The Examiner further argues that, notwithstanding the fact that Kight discloses only the verification of a bank account

number (and not a merchant account number) in the referenced text, this is equivalent to the recited validation of the payee account number according to validation rules corresponding to payee values for fields of the account number. The Examiner also points out that Kight in column 7, lines 10-12, does disclose validation of a merchant's account.

However, although Kight, in columns 3, lines 4-9 and 7, lines 10-12, does generally disclose the need for validation of the bank and payee account numbers, Kight does not disclose any particulars as to how these validations are performed. Further, there is nothing in Kight to suggest that the bank account number and the payee account number should or could be validated in the same way. Hence, Kight lacks any suggestion that the payee account number is validated in accordance with validation rules corresponding to payee values for fields of the account number.

The Examiner points to Pintsov (column 10, lines 61-65, column 11, lines 56-67, and column 12, lines 1-4) as teaching a unique identifier with an error correction code and a validation process.

However, Pintsov fails to disclose what the referenced error correction code is used for. Pintsov does disclose a simple encryption validation process but lacks any teaching or suggestion whatsoever of validating an account number based on validation rules corresponding to payee values for fields of the account number.

The Examiner further argues that, notwithstanding Pintsov's failure to disclose what the referenced error correction code is used for, Pintsov's disclosure of an undefined encryption validation process in column 11, line 56, through column 12, line 4, validates the mailer identification file, including an account number. The Examiner contends that this is equivalent to the recited validation of the payee account number according to validation rules corresponding to payee values for fields of the account number.

However, although Pintsov does disclose a simple encryption validation process, Pintsov lacks any teaching or suggestion

whatsoever of validating an account number based on validation rules corresponding to values for fields of the account number. In fact, Pintsov's account number 302 is never validated. Rather, as described in the referenced text, only the addresses 304 in the mailing identification file 122 are validated by matching the number of characters in each address 304 to the applicable numeric in the unique ID 306.

With regard to claims 9, 15, 21 and 24, the Examiner acknowledges that Kight fails to teach identifying one of a plurality of remittance centers, and points to Pintsov (column 11, lines 39-51) as disclosing the use of a zip code to identify a single delivery point to which delivery is directed.

However, Pintsov lacks any disclosure of using a merchant account number to identify one of a plurality of different delivery points associated with a single entity as recited.

The Examiner further argues that Pintsov discloses mailing files that include a mailer account number and which are accessed to retrieve a destination delivery code. The Examiner asserts that even though the mailer's account (not the merchant's account) is used by Pintsov, all steps for the identification are disclosed.

The applicable claims require that a single payee have a plurality of remittance centers and that an account number be processed to identify a single one of the plurality of remittance centers to which payment for that payee is to be directed. Pintsov lacks any disclosure whatsoever of processing an account number, let alone processing an account number to determine a destination address of the recipient. Rather, the only account number disclosed by Pintsov (i.e. account number 302) simply identifies the mailer.

Furthermore, even if Pintsov's unique ID were disclosed to correspond to an account number (which is clearly not the case), the unique ID identifies the address of the recipient (who is not a payee in Pintsov), and not the carrier carrier service which is the only payee in Pintsov.

Moreover, the unique ID is selected to identify only a

single address.   Hence, there is absolutely no need to process a
unique ID to identify which one of multiple addresses mail should
be directed to.

With regard to claim 23, in a non-final Official Action the
Examiner acknowledged that Kight fails to disclose transformation
of an account number based upon alteration rules, but pointed to
Pintsov (column 10, lines 61-65 and column 7, lines 49-52) as
teaching a unique identification number having a specific format
and transforming mail address codes into new delivery point
postal codes. On this basis, the Examiner concluded that it was
obvious to format account numbers in accordance with alteration
rules in order to make sure that the payment is from the correct
payer.

However, Pintsov lacks any disclosure of altering the unique
identification number. What Pintsov does disclose is altering the
zip code due to an address change. Hence, as discussed above,
Pintsov's alterations could be used in conjunction with the
present invention to update the merchant database, but clearly
fail to make obvious the recited alteration of the account
number.

The Examiner, in the Final Official Action now contends that
Pintsov in column 10, lines 61-65, discloses that each mailing
file includes a unique ID (associated with an account code and
having a specific format) and addresses listed in the file. The
Examiner further asserts that Pintsov discloses altering the zip
code due to an address change, and that the format of the unique
identifier will change depending on the mailer because the mail
piece count 312 and the number of address characters 314 will be
different for each mailer on the mailing list.

However, claim 23 requires that a payor account number be
transformed according to alteration rules indicative of a format
of account numbers of the payee.   The only account number
disclosed by Pintsov (i.e. mailer account number 302), is not
disclosed by Pintsov to be altered in any way.   Further, even if
the unique ID 402 were to be considered to correspond to an
account number (which would be improper), although the content of

the ID may change as discussed in column 10, lines 61-65, there is nothing within Pintsov to suggest that the format as shown in Figures 3 and 4, could be, let alone would be changed.

In fact, as disclosed by Pintsov, altering the zip code 404 due to a change in the address 304, the mail piece count 312 and/or the number of address characters 314 will have no effect whatsoever on the format of the unique ID 306. Furthermore, there is nothing in Pintsov to suggest that a received unique ID is somehow processed and altered. Rather, implicit in Pintsov is that received unique ID, which is used to access the corresponding mail processing file to retrieve the deliver point postal code, should not be modified, since this would lead to an improper deliver point postal code being retrieved.

In summary, it is respectfully submitted that the applied combination of art lacks any teaching or suggestion of the following recited claim features:

1) processing the received payment information other than received payee zip code to identify an eleven digit zip code for a payee, and accessing the database of payee records to locate the payee record having the payee zip code corresponding to the identified eleven-digit zip code, as required by independent claim 1.

2) processing the received name, city and state information to identify an eleven digit zip code for a payee, and accessing the database of merchant records to locate the merchant record for the merchant corresponding to the identified eleven-digit zip code, as required by independent claim 10.

3) a processor configured to process the payment information, excluding the received payee zip code, to produce an eleven-digit zip code for the payee and to retrieve one or more of the plurality of payee records having an associated zip code corresponding to the eleven-digit zip code from the storage device code, as required by independent claim 11.

4) software which causes a processor to process the payment information, excluding the received payee zip code, to identify an eleven digit zip code for the payee, and to access a database

of payee records to locate a payee record corresponding to the eleven-digit zip code within a database, as required by independent claim 16.

5) a second station, coupled to the network, configured to receive the payment information from the first station via the network, process the payment information to produce an eleven digit zip code for the payee, and access the database to locate a payee record for the payee corresponding to the eleven digit zip code, as required by independent claim 22.

6) determining if the stored payee name information and the stored payee address information included in any of the plurality of payee records correspond to the received payee name information and the received payee address information, directing payment in accordance with a first of the plurality of payee records if the stored payee name information and the stored payee address information included in the first payee record is determined to correspond to the received payee name information and the received payee address information, processing the received payee address information to identify an eleven digit zip code if none of the plurality of payee records include stored payee name information and stored payee address information which is determined to correspond to the received payee name information and the received payee address information, determining if the stored payee zip code included in any of the plurality of payee records corresponds to the identified eleven-digit zip code, and directing payment in accordance with a second of the plurality of payee records if the stored payee zip code included in the second payee record is determined to correspond to the identified eleven-digit zip code, as required by independent claim 28.

7) locating a payee record (i) by matching an identified eleven digit zip code with the zip code in the database payee record or (ii) by matching a portion of the received payee name with a portion of the payee name in the database payee record, as required by claim 5.

8) comparing a portion of the payee name with a payee name in the payee record to locate a payee record, as required by claim 19.

9) a second station configured to compare a portion of the payee name with a payee name in the payee record in the database to locate a payee record, as required by claim 27.

10) a database including alteration rules for altering the account number and validation rules corresponding to payee values for fields of the account number for validating the account number, verifying that the account number conforms to the validation rules, and transforming the verified account number into an altered account number according to the alteration rules, as required by claim 8.

11) a storage device configured to store verification rules corresponding to payee values for fields of the account number and alteration rules, associated with the payee, and a processor configured to process the payment information to verify that the payor account number conforms to the validation rules associated with the payee and to alter the payor account number according to the alteration rules associated with the payee, as required by claim 14.

12) verifying that the received account number conforms to validation rules corresponding to payee values for fields of the account number, and transforming the verified account number into an altered account number according to the alteration rules of the payee, as required by claim 20.

13) processing of an account number to identify one of the plurality of remittance centers to which payment for a payee is to be directed and directing the payment and the altered account number to the identified remittance center, as required by claim 9.

14) a processor configured to process the payor account number to identify a single remittance center of the plurality of remittance centers associated with a payee to which payment is to be directed and to direct payment to the single remittance center, as required by claim 15.

15) processing the verified account number to identify a single remittance center of the plurality of remittance centers of a payee, and directing payment to the single remittance center, as required by claim 21.

16) a second station configured to process the received account number to identify a single remittance center of the plurality of remittance centers of a payee, and to direct a payment and an altered payor account number to the single remittance center, as required by claim 24.

17) transforming a payor account number according to alteration rules indicative of a format of account numbers of the payee, as required by claim 23.

Accordingly, it is respectfully submitted that the applied combination of prior art references lacks any teaching or suggestion of features of the invention as claimed in the present application.

CONCLUSION

It is respectfully submitted that the Examiner has (i) failed to establish a prima facie case for the rejection, (ii) ignored features explicitly required by the claims, (iii) failed to reasonably construe that which is taught and suggested by the applied prior art combination, (iv) used improper hindsight to reconstruct the invention recited in the rejected claims, (v) failed to apply art which teaches or suggests the claimed invention and (vi) applied art in a manner inconsistent with its teachings.

Thus, it is respectfully submitted that the rejection of claims 1-11 and 13-28 as obvious under 35 U.S.C. §103(a) over the applied prior art combination is improper.

In summary, Applicants respectfully submit that the applied combination of references does not teach or suggest features recited in rejected independent claims upon which all other pending claims depend. It is further respectfully submitted that the applied references also fail to disclose numerous other features recited in the pending dependent claims. Accordingly, it

is submitted that the applied art combination does not provide any teaching, or suggestion within its teachings, which would lead to the features (or advantages) of the instant invention, and the claims patentably define over the art.

The rejection of claims 1-11 and 13-28 under 35 U.S.C. §103(a) is in error and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-0429 and please credit any excess fees to such deposit account.

Respectfully submitted,

LALOS & KEEGAN
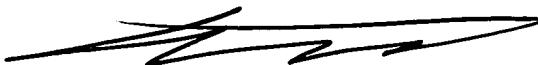
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APPENDIX

1. (Amended) A computer implemented method for payment remittance processing, comprising the steps of:

establishing a database including payee records, each payee record having a payee zip code;

receiving a payor's payment information, including a payee zip code;

processing the payment information other than the received payee zip code to identify an eleven digit zip code for a payee; and

accessing the database to locate the payee record having the payee zip code corresponding to the identified eleven-digit zip code.

2. (Amended) The method of claim 1, wherein:

the received payment information includes the received payee zip code and other payee address information; and

the processed payment information includes only a portion of the other payee address information.

3. (Amended) The method of claim 1, wherein:

the received payment information includes a payee city and a payee state; and

the processed payment information includes the payee city and the payee state.

4. (Amended) The method of claim 1, wherein:

each payee record has a payee name;

the received payment information includes a payee name; and

the database is accessed to locate the payee record having the payee name and the zip code corresponding to only a portion of the received payee name and the identified eleven digit zip code.

5. (Amended) The method of claim 4, further comprising the step of:

locating the payee record by matching the identified eleven digit zip code with the payee record zip code in the database, and matching the portion of the received payee name with a portion of the payee record payee name in the database.

6. The method of claim 1, further comprising the step of:

making a payment to the payee after locating the payee record.

7. The method of claim 6, wherein:

the payment is an electronic payment.

8. (Amended) The method of claim 1, wherein the received payment information includes a payor account number with the payee, the database includes alteration rules for altering the account number and validation rules corresponding to payee values for fields of the account number for validating the account number, and further comprising the steps of:

verifying that the account number conforms to the validation rules; and

transforming the verified account number into an altered account number according to the alteration rules.

9. (Amended) The method of claim 8, wherein the payee has a plurality of remittance centers, and further comprising:

processing the account number to identify one of the plurality of remittance centers to which payment is to be remitted; and

directing the payment and the altered account number to the identified remittance center.

10. A computer implemented process for ensuring the integrity of data comprising:

receiving name, street address, city and state information associated with a merchant;

processing the name, city and state information to identify

an eleven digit zip code; and

accessing a database of merchant records to locate a merchant record for the merchant corresponding to the eleven digit zip code.

11. (Amended) An automated remittance processing system, comprising:

a storage device configured to store payee records, each payee record having an associated one of a plurality of payee zip codes;

a data input unit configured to receive a payor's payment information, including a zip code of a payee; and

a processor configured to process the payment information, excluding the received payee zip code, to produce an eleven-digit zip code for the payee and to retrieve one or more of the plurality of payee records having the associated zip code corresponding to the eleven-digit zip code from the storage device.

13. (Amended) The automated remittance processor of claim 11, wherein the processor is further configured to direct a payment to the payee in accordance with the retrieved payee record.

14. (Amended) The automated remittance processor of claim 11, wherein:

the payment information includes a payor account number with the payee;

the storage device is further configured to store verification rules corresponding to payee values for fields of the account number and alteration rules, associated with the payee; and

the processor is further configured to process the payment information to verify that the payor account number conforms to the validation rules associated with the payee and to alter the payor account number according to the alteration rules associated with the payee.

15. (Amended) The automated remittance processor of claim 14, wherein:

the payee has a plurality of remittance centers;

the processor is further configured to process the payor account number to identify a single remittance center of the plurality of remittance centers to which payment is to be directed and to direct payment to the single remittance center.

16. (Amended) An article of manufacture for processing payment information, comprising:

computer readable storage medium; and

a computer program stored on the storage medium;

wherein the stored computer program is configured to be readable from the computer readable storage medium by a computer and thereby cause the computer to operate so as to:

receive payment information from a payor, including a zip code of a payee;

process the payment information, excluding the received payee zip code, to identify an eleven digit zip code for the payee; and

access a database of payee records to locate a payee record corresponding to the eleven-digit zip code within the database.

17. (Amended) The article of manufacture of claim 16, wherein the received payment information includes the received payee zip code and payee address information, and the computer program is further configured to cause the computer to operate so as to:

process only a portion of the payee address information.

18. (Amended) The article of manufacture of claim 17, wherein the received payment information includes a name of the payee, and the computer program is further configured to cause the computer to operate so as to:

access the database using a portion of the received payee name and the eleven digit zip code to locate the payee record;

and

the payee record further corresponds to the portion of the payee name.

19. (Amended) The article of manufacture of claim 18, wherein the computer program is further configured to cause the computer to operate so as to:

compare the portion of the payee name with a payee name in the payee record.

20. (Amended) The article of manufacture of claim 16, wherein the payment information includes a payor account number with a payee, and the computer program is further configured to cause the computer to operate so as to:

verify that the received account number conforms to validation rules corresponding to payee values for fields of the account number; and

transform the verified account number into an altered account number according to the alteration rules of the payee.

21. The article of manufacture of claim 20, wherein the payee has a plurality of remittance centers, and the computer program is further configured to cause the computer to:

process the verified account number to identify a single remittance center of the plurality of remittance centers; and

direct payment to the single remittance center.

22. (Amended) A system for processing payment information comprising:

a network;

a first station, coupled to the network, configured to generate payment information, including a payee name, payee address data, and a payor account number with a payee;

a database including payee records; and

a second station, coupled to the network, configured to receive the payment information from the first station via the

network, process the payment information to produce an eleven digit zip code for the payee, and access the database to locate a payee record for the payee corresponding to the eleven digit zip code.

23. (Amended) The system of claim 22, further comprising:

alteration rules indicating a format for account numbers of the payee;

wherein the second station transforms the received payor account number into an altered payor account number according to the alteration rules.

24. (Amended) The system of claim 23, wherein the payee has a plurality of remittance centers and the second station is further configured to process the received account number to identify a single remittance center of the plurality of remittance centers, and to direct a payment and the altered payor account number to the single remittance center.

25. (Amended) The system of claim 22, wherein:

the payment information includes a portion of a payee name and a portion of payee address.

26. (Amended) The system of claim 22, wherein:

the second station is further configured to access the database using a portion of a payee name and the eleven digit zip code to locate the payee record; and

the payee record further corresponds to the portion of the payee name.

27. (Amended) The system of claim 26, wherein:

the second station is further configured to compare the portion of the payee name with a payee name in the payee record in the database.

28.   A computer implemented method for payment remittance
processing, comprising the steps of:

establishing a database having a plurality of payee records
associated with a plurality of payees, each payee record
including stored name information and stored address information,
including a zip code, of its associated payee;

receiving a payee name information and a payee address
information, including a zip code;

determining if the stored payee name information and the
stored payee address information included in any of the plurality
of payee records correspond to the received payee name
information and the received payee address information;

directing payment in accordance with a first of the
plurality of payee records if the stored payee name information
and the stored payee address information included in the first
payee record is determined to correspond to the received payee
name information and the received payee address information;

processing the received payee address information to
identify an eleven digit zip code if none of the plurality of
payee records include stored payee name information and stored
payee address information which is determined to correspond to
the received payee name information and the received payee
address information;

determining if the stored payee zip code included in any of
the plurality of payee records corresponds to the identified
eleven-digit zip code; and

directing payment in accordance with a second of the
plurality of payee records if the stored payee zip code included
in the second payee record is determined to correspond to the
identified eleven-digit zip code.